

DAK #10

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

OLWIN et al.

Serial No.: 09/377,675

Filed: August 19, 1999

Atty. File No.: 2848-32

For: "CHIMERIC FIBROBLAST GROWTH
FACTOR PROTEINS, NUCLEIC ACID
MOLECULES, AND USES THEREOF"

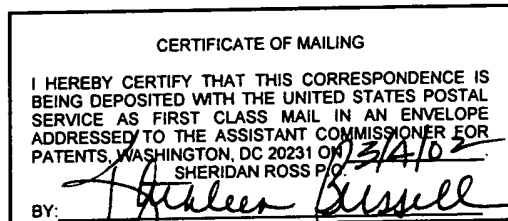


Group Art Unit: 1646

Examiner: Chernyshev, O.

PETITION FOR REVIVAL
OF APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY
(Under 37 CFR 1.137(b))

Assistant Commissioner For Patents
Washington, D.C. 20231



Dear Sir:

The above-identified patent application became abandoned for failure to file a timely and proper reply to the Office Action mailed on December 6, 2000, which set a one-month period for reply. The abandonment date of this application is January 7, 2001.

Applicant hereby petitions for the revival of this application. Enclosed herewith, pursuant to 37 CFR 1.137(b), are:

(1) A petition fee in the amount of \$640 for a small entity. Applicant has previously claimed small entity status and such status is still proper.

(2) A reply to the above-noted Office Action in the form of a Response to Restriction Requirement; and

(3) A statement that the entire delay was unintentional, including a showing how the entire delay in filing the grantable petition pursuant to 37 CFR 1.137(b) occurred.

Please debit any deficiencies in any fees to Deposit Account 19-1970.

Respectfully submitted,

SHERIDAN ROSS P.C.

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03/18/2002 GTEFFERA 00000153 09377675

01 FC:241

640.00 DP

By:

Angela K. Dallas
Registration No. 42,460
1560 Broadway, Suite 1200
Denver, CO 80202-5141
(303) 863-9700

Date: March 4, 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In Re the Application of:

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Group Art Unit: 1646

Examiner: Chernyshev, O.

RESPONSE TO
RESTRICTION REQUIREMENT

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS
BEING DEPOSITED WITH THE UNITED STATES POSTAL
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ADDRESSED TO THE ASSISTANT COMMISSIONER FOR
PATENTS, WASHINGTON, DC 20231 ON 3/14/02
SHERIDAN ROSS P.C.

BY: *[Signature]*

Assistant Commissioner For Patents
Washington, D.C. 20231

Dear Sir:

This Response is filed in Response to a Restriction Requirement having a mailing date of December 6, 2000, and in conjunction with a Petition for Revival of an Abandoned or Lapsed Patent pursuant to 37 CFR 1.137(b). All fees due in connection with the Petition under 37 CFR 1.137(b) are enclosed herewith. In the event that any additional fees are due, please debit Deposit Account No. 19-1970.

The Examiner has restricted the invention into the following six groups of claims, as follows:

Group I (Claims 1-6[sic] and 8-18), directed to fibroblast growth factor-1;

Group II (Claims 1-18), directed to fibroblast growth factor-2;

Group III (Claims 19-23 and 25-37), directed to nucleic acids encoding FGF-1, host cells and recombinant methods of production;

Group IV (Claims 19-37), directed to nucleic acids encoding FGF-2; host cells and recombinant methods of production;

Group V (Claims 38-41), directed to methods of altering the differentiation state of a cell;
and

Group VI (Claim 42), directed to a method of regulating cell metabolism.

Applicants provisionally elect to prosecute the claims of Group II (Claims 1-18), directed to chimeric FGF-2, with traverse.

Applicants traverse the restriction between the claims of Groups I and II, and between either of I and/or II and Groups V and/or VI. With regard to Groups I and II, Applicants note that the Patent Office may require restriction if two or more "independent and distinct" inventions are claimed in one application. However, "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." M.P.E.P. Section 803. Applicants submit that a thorough search for Group I should also include the subject matter of Group II. In the present case, the subject matter of these Groups cited by the Examiner is sufficiently small and is so closely related as to be capable of examination together. The restriction requirements in this case only serve to increase the prosecution expense to the Applicants and to the Patent and Trademark Office. Applicants respectfully request that the Examiner withdraw the restriction requirements.

With regard to either of Groups I or II and the method claims of Groups V and/or VI, Applicants submit that the method of Groups V or VI require the use of the chimeric FGF of Groups I or II. In any event, if the elected claims of Group II are found allowable, Applicants reserve their right to amend the claims of Group V or VI to be commensurate in scope with the product claims of Group II, and to request that such amended method claims that depend from or otherwise include all the limitations of the allowable product be rejoined and examined for patentability. In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1996); In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995).

In view of the foregoing remarks, Applicants respectfully request that the Examiner withdraw the restriction between Groups I and II, and between Groups I and II and Groups V and VI.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: Angela Dallas
Angela K. Dallas
Registration No. 42,460
1560 Broadway, Suite 1200
Denver, CO 80202-5141
(303) 863-9700

Date: March 4, 2002



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In Re the Application of:

OLWIN et al.

Serial No.: 09/377,675

Filed: August 19, 1999

Atty. File No.: 2848-32

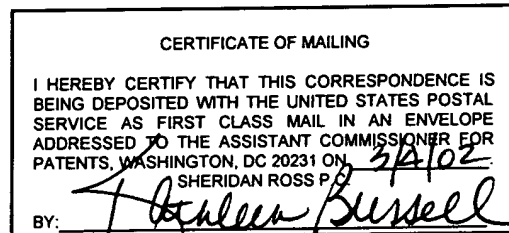
For: "CHIMERIC FIBROBLAST GROWTH
FACTOR PROTEINS, NUCLEIC ACID
MOLECULES, AND USES THEREOF"

) Group Art Unit: 1646

) Examiner: Chernyshev, O.

) STATEMENT PURSUANT TO
) 37 CFR 1.137(b)(1)

Assistant Commissioner For Patents
Washington, D.C. 20231



Dear Sir:

This statement is provided under 37 CFR 1.137(b) in conjunction with a Petition For Revival of Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b).

The entire delay in filing the required reply to the Office Action mailed on December 6, 2000, from the due date for the reply until the filing of the grantable petition pursuant to 37 CFR 1.137(b), was unintentional.

The following discussion is a showing of how the entire delay in filing the grantable petition pursuant to 37 CFR 1.137(b) occurred, despite the exercise of due care and diligence on the part of the Applicants and Applicants' representatives.

1. In August, 2001, Applicants' agent, Angela Dallas, became aware that there had been an Office Action mailed in the above-identified application, and that a response to the Office Action had not been received. This notification occurred by way of a telephone message left for Dr. Dallas by Examiner Chernyshev. Dr. Dallas left telephone messages for Examiner Chernyshev on August 1, August 2, and August 3, 2001, indicating that no Office Action had been received and requesting that the Examiner to call Dr. Dallas to discuss the issue. On August 7, 2001, the Examiner left a telephone message for Dr. Dallas indicating that the application may be abandoned, and Dr. Dallas left a telephone message for the Examiner requesting a discussion regarding the non-receipt of the

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Office Action. The Examiner and Dr. Dallas discussed the application by way of a telephone conference on August 8, 2001. The Examiner indicated that the Office Action had been mailed to Sheridan Ross P.C. at 1700 Lincoln St., Denver, CO 80202. Dr. Dallas explained to the Examiner that the law firm of Sheridan Ross P.C. had moved, and that a global change of address diskette containing applications and patents handled by Sheridan Ross P.C. had been filed with the Patent Office and that such diskette, to the best of Dr. Dallas' knowledge at that time, contained the above-identified application. Dr. Dallas asked the Examiner to resend the Office Action to the correct address and to restart the period for response. Examiner Chernyshev indicated that she was new, that her Primary Examiner was on vacation, and that she did not know whether she could resend the Office Action. Examiner Chernyshev indicated that she would check with another Examiner to see if the Office Action could be resent.

2. Applicants' agent first became aware that a Notice of Abandonment had been mailed by way of a second telephone call from Examiner Chernyshev to Angela Dallas in August 2001, subsequent to the August 8, 2001 telephone discussion. The Examiner informed Dr. Dallas that she had now mailed a Notice of Abandonment to Sheridan Ross P.C. at 1700 Lincoln St., Denver, CO 80202. It is noted that the Examiner's action occurred despite Dr. Dallas' clear notification of the Examiner during the August 8, 2001 telephone discussion of the change of address for Sheridan Ross P.C. Angela Dallas explained again that the law firm of Sheridan Ross P.C. had moved, and informed the Examiner that, like the December 6 Office Action, Sheridan Ross P.C. would not receive the Notice of Abandonment, and that receipt of such documents was imperative. Examiner Chernyshev stated that she did not know if she could resend the Notice of Abandonment or December 6 Office Action by mail or by facsimile. Examiner Chernyshev contacted Dr. Dallas again within a few days, indicated that she had sent the file back to the appropriate repository within the Patent Office, and indicated that Sheridan Ross P.C. would have to just "wait and see" if the Notice of Abandonment would be returned to the U.S. Patent Office as undeliverable, at which time, the Examiner might contact Dr. Dallas again to re-mail the Notice. The Examiner would not agree to take any additional action at that time to ensure that Sheridan Ross P.C. would receive the Notice of Abandonment. On August 27, 2001, Dr. Dallas filed a Notice of Change of Address, so that, if

the Notice of Abandonment was returned to the Examiner as undeliverable, the file would contain a record of the appropriate correspondence address.

3. On October 18, 2001, Dr. Dallas conducted a telephone conference with the Examiner to notify her that the Notice of Abandonment had not been received by Sheridan Ross P.C., and to request that the Examiner remail or send a copy of the Notice to the current address for Sheridan Ross P.C. On October 26, 2001, Examiner Chernyshev contacted Dr. Dallas to notify her that she had obtained the file and that she would send a facsimile copy of the Notice of Abandonment. Therefore, Applicants first came into possession of the actual Notice of Abandonment on October 26, 2001. A copy of the Notice of Abandonment and the dated cover sheet from the Examiner is attached. Dr. Dallas stressed to the Examiner that Applicants still needed to receive a copy of the December 6 Office Action in order to reply to the Action and to complete the requirements for revival of the application. The Examiner stated that she did not know if she could send a copy of the December 6 Office Action. Dr. Dallas explained that without the Action, Applicants could not complete the revival process. The Examiner informed Dr. Dallas that she would ask internally whether a copy of the Office Action could be sent. The Examiner contacted Dr. Dallas within a few days and informed Dr. Dallas that the file had again been returned to a repository within the Patent Office and could not currently be retrieved, but that Dr. Dallas should try to obtain a copy of the Office Action through the Customer Service Department for Group 1600.

4. Between October 26, 2001 and January 15, 2002, Dr. Dallas made multiple telephone calls and left several messages with various personnel within the Patent Office Customer Service Department for Group 1600 and other departments within the Patent Office. Many telephone messages left by Dr. Dallas were not returned. When telephone calls were returned, Dr. Dallas was given various, differing information, including: that the file was unavailable, that a request for the file to be retrieved by Group 1600 Customer Service would be made, that the Office Action copy could not be obtained through Group 1600 Customer Service, and finally that an outside courier would have to be sent to copy the Office Action at the Patent Office. Dr. Dallas promptly arranged for a Washington D.C. law firm to inspect the file and make the required copy on January 10, 2002 (copy of the letter to the law firm is attached), but when a representative of the Washington D.C. law firm arrived to inspect the file, the representative was told that the file was unavailable. On January

15, 2002, Ms. Brown of Group 1600 Customer Service Department suddenly contacted Dr. Dallas, informed Dr. Dallas that she had retrieved the file, and sent the copy of the December 6 Office Action to Dr. Dallas by facsimile. A copy of this facsimile transmission is enclosed, including the dated cover sheet.

5. On January 16, 2002, Dr. Dallas sent the Office Action to the Applicant with a request for a decision on how to respond to the Office Action so that the application could be revived. Applicants have responded to Dr. Dallas and the documents associated with the Request for Revival according to 37 CFR 1.137(b) have now been prepared. Revival of the above-identified application is respectfully requested.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: Angela Dallas
Angela K. Dallas
Registration No. 42,460
1560 Broadway, Suite 1200
Denver, CO 80202-5141
(303) 863-9700

Date: March 4, 2002



UNITED STATES
PATENT AND
TRADEMARK OFFICE



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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

DATE: 10/26/01

FROM: OLGA N. CHERNYSHEV

PAGES, INCLUDING COVERSHEET: 2 (two)

PHONE NUMBER: 703 305 1003

FAX/TELECOPIER NUMBER: (703) 308-0294

TO: ANGELA DALLAS

FIRM: SHERIDAN ROSS

SERIAL NUMBER: 09/377,675

FAX/TELECOPIER NUMBER: 303 863 0223

COMMENTS: Not. of Abn. Please call 703 305 1003
to confirm the receipt.

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OCT 26 2001

SHERIDAN, ROSS

IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE TELEPHONE NUMBER LISTED ABOVE.

IN COMPLIANCE WITH 1096 CG 30, THE FILING DATE ACCORDED EACH OFFICIAL FAX TRANSMISSION WILL BE DETERMINED BY THE FAX MACHINE DATE STAMP FOUND ON THE LAST PAGE OF THE TRANSMISSION, UNLESS THAT DATE IS A SATURDAY, SUNDAY, OR FEDERAL HOLIDAY WITHIN THE DISTRICT OF COLUMBIA, IN WHICH CASE THE OFFICIAL DATE OF RECEIPT WILL BE THE NEXT BUSINESS DAY.

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COPY OF PAPERS
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Application No.

09/377,675

Examiner

Olga N. Chernyshev

Applicant(s)

OLWIN ET AL.

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 06 December 2000.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance.
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file new formal drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed new formal drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ The proposed new formal drawings filed on _____ are not acceptable and the period for reply has expired.
 - (c) ☐ No proposed new formal drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

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Gary L. Kunz
 GARY L. KUNZ
 SUPERVISORY PATENT EXAMINER
 TECHNOLOGY CENTER 1600



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OF COUNSEL
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*MI, AL, IN Bar Only

TECHNICAL SPECIALISTS
DENNIS J. DUPRAY, Ph.D.
ANGELA K. DALLAS, Ph.D.

January 10, 2002

Mr. Carl Jennison
Jennison & Schultz P.C.
Crystal Plaza #1, Suite 1102
2001 Jefferson Davis Hwy.
Arlington, VA 22202

VIA FACSIMILE

Re: U.S. Patent Serial No. 09/377,675, filed August 19, 1999
Our Ref. 2222

Dear Carl:

This application was abandoned because of a failure to receive or respond to an office action (restriction requirement) that was apparently mailed to us in December 2000. Would you please obtain a copy of that office action and send it to us by FedEx.

Please call if you have any questions.

Best regards,

SHERIDAN ROSS P.C.

Angela K. Dallas, Ph.D.

Enclosure

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

OLWIN et al.

Serial No.: 09/377,675

Filed: August 19, 1999

Atty. File No.: 2848-32

For: "CHIMERIC FIBROBLAST GROWTH
FACTOR PROTEINS, NUCLEIC ACID
MOLECULES, AND USES THEREOF"



POWER TO INSPECT
(37 CFR § 1.14)

Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

As the below-named agent of the assignee of the above-identified Application, with full power to transact business in the United States Patent and Trademark Office with respect to the above-identified Application, I hereby authorize Ms. Kathryn Jennison Shultz, Mr. John N. Jennison, Mr. Carl Jennison, Mr. Ellsworth M. Jennison, and/or a representative thereof to inspect said Application and obtain copies thereof on my behalf.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: Angela Dallas
Angela K. Dallas
Registration No. 42,460
1560 Broadway, Suite 1200
Denver, CO 80202-5141
(303) 863-9700

Date: January 10, 2002

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TECHNICAL SPECIALISTS
DENNIS J. DUPRAY, Ph.D.
ANGELA K. DALLAS, Ph.D.

January 10, 2002

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Please deliver the following pages to:

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Sender's Name: Angela K. Dallas

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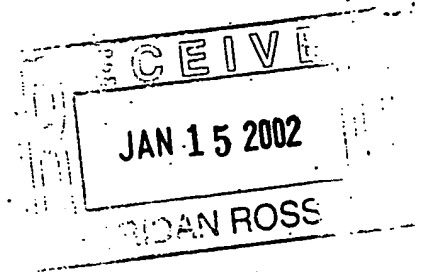
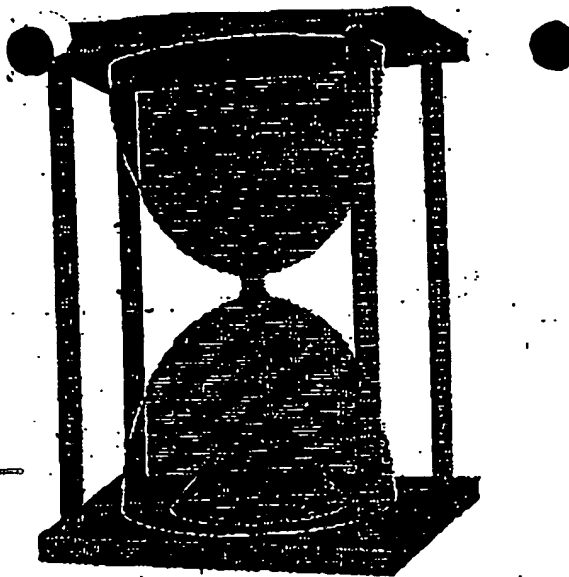
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DATE: 1.15.02

ATTN: Angie Dallas

Fax Number: (303) 863-0223

FROM: Yvonne Brown

Fax Number: (703) 308-4407

NUMBER OF PAGES 8 INCLUDING THIS PAGE.

REMARKS: _____

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CONTACT Yvonne AT (703) 308-0198

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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02/077,675 08/19/99 OLWIN

B 2848-32

EXAMINER

HM22/1266

GARY J CONNELL
SHERIDAN ROSS PC
1700 LINCOLN STREET SUITE 3500
DENVER CO 80202

CHERNYSHEV, G	
ART UNIT	PAPER NUMBER

1646
DATE MAILED:

12/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/377,675

Applicant(s)

OLWIN ET AL.

Examiner

Olga N. Chernyshev

Art Unit

1846

— The MAILING DATE of this communication appears in the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-42 are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16 and 8-18, drawn to fibroblast growth factor-1, classified in class 530, subclass 399, for example.
 - II. Claims 1-18, drawn to fibroblast growth factor-2, classified in class 530, subclass 399, for example.
 - III. Claims 19-23 and 25-37, drawn to nucleic acids encoding FGF-1, host cells and recombinant methods of production of FGF-1, classified in class 435, subclass 69.1, for example.
 - IV. Claims 19-37, drawn to nucleic acids encoding FGF-2, host cells and recombinant methods of production of FGF-2, classified in class 435, subclass 69.1, for example.
 - V. Claims 38-41, drawn to methods of altering the differentiation state of the cell, classified in class 435, subclass 377, for example.
 - VI. Claim 42, drawn to a method of regulating of cell metabolism, classified in class 435, subclass 375, for example.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions (I and III) and (II and IV) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the

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instant case the different inventions are directed to different proteins, fibroblast growth factors 1 and 2 (Groups I and III), and methods of their production (Groups II and IV), respectively. FGF-1 and FGF-2 have different functions and different expression profiles, different intracellular sites of action, they also can be made or used without each other.

3. Inventions (I-II) and (III-IV) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of Groups III-IV could be used in an entirely different method, such as in a method of detection of the polynucleotide in a sample, rather than in a method of making the polypeptide.

4. Inventions (I-II) and (V-VI) are also unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the fibroblast growth factors of Groups I-II can be used in an entirely different method, such as in a method of preparing antibodies, rather than in methods of regulating cell cycle or cell physiology of Groups V-VI.

5. Inventions (III-IV) and (V-VI) are unrelated, respectively. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the polynucleotides of Groups III-IV are not required for the methods of

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Groups V-VI, and can be used for a different set of methods, such as production of polypeptides and detection of polynucleotides in a sample, rather than in methods of cell cycle regulation.

6. Inventions V and VI are unrelated, too. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are directed to different methods that recite different steps, achieve different goals and are not required one for the other.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter and non-coextensive literature searches, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (703) 305-1003. The examiner can normally be reached on Monday to Friday 9 AM to 5 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-0294 for After Final communications.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)0. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556 or (703) 308-4242. If either of these numbers is out of service, please call the Group receptionist for an alternative number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

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Olga N. Chernyshev, Ph.D.
December 04, 2000

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CHRISTINE J. SAUD
PRIMARY EXAMINER

Christine J. Saud

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